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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,143	06/21/2005	Makoto Katsumata	050396	3589
23850 7590 08/13/2007 KRATZ, QUINTOS & HANSON, LLP 1420 K Street, N.W. Suite 400 WASHINGTON, DC 20005			EXAMINER MAYO III, WILLIAM H	
			ART UNIT 2831	PAPER NUMBER
			MAIL DATE 08/13/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/540,143

Applicant(s)

KATSUMATA ET AL.

Examiner

William H. Mayo III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. Claims 1 & 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masuda et al (JP Pat Num 06-190315, herein referred to as Masuda) in view of Kondo (JP Pat Num 10-031918). Masudo discloses an electrical cable (Figs 1-11) having a conductor core (3) and a sheathing layer (not number) covering the core (3), wherein the sheathing layer (not numbered) is made by a synthetic material having an outer surface with a mono color (paragraph 7), wherein the freedom of marking and lay out of the cable can be improved (see abstract under purpose). Specifically, with respect to claim 1, Masudo discloses an electrical cable (Figs 9 & 11) comprising a first mark (M1) having a first color and provided on a first part (left end) of an outer surface of the sheathing layer (not numbered), and a second mark (M2) having a second color (paragraph 9) and provided on a second part (right end) of the outer surface of the sheathing layer (not numbered), wherein the second color is provided by an ink feeder (10<sub>2</sub>) that is a different from a first color which is provided by a second ink feeder (10<sub>1</sub>, paragraph 9), wherein the second part (right end) is positioned on a opposite side of the first side (left end) in a lateral direction of the cable (Fig 9), wherein the first mark (M1) different than the second mark (M2) in a longitudinal direction of the cable (Fig 9b), wherein the sheathing layer (not shown) of the cable (6) has a first outer surface (outer surface of the left end) and a second outer surface (outer surface of right end), wherein the first and second outer surface (outer surface of the right and left ends, respectively), each extending in a longitudinal direction of the cable (Fig 12), wherein the first outer surface (outer surface of the left end) is positioned oppositely to the second outer surface (outer surface of the right end) in a lateral direction of the cable (Fig 9), wherein

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the first and second outer surfaces (outer surfaces of the left and right ends) are provided with a plurality of first and second marks (M1 & M2) that are alternately positioned (Fig 9) in a longitudinal direction, wherein the first mark (M1) and the second mark (M2) are positioned at an end of the cable (Fig 9b). With respect to claim 4, Masudo discloses that the sheathing layer (not numbered) of the cable (Fig 11) has a first outer surface (outer surface of the left end) and a second outer surface (outer surface of right end), wherein the first and second outer surface (outer surface of the right and left ends, respectively), each extending in a longitudinal direction of the cable (Fig 12), wherein the first outer surface (outer surface of the left end) is positioned oppositely to the second outer surface (outer surface of the right end) in a circumferential direction of the cable (Fig 11) with regular intervals (Fig 9b & 11, both shown the ink deposit nozzles being on opposite sides with respect to a circumferential direction) and wherein the first and second outer surfaces (outer surfaces of the left and right ends) are provided with a plurality of first and second marks (M1 & M2, respectively) that are alternately positioned (Fig 9b).

However, Masudo doesn't necessarily disclose the first mark being longer than the second mark (claim 1).

Kondo teaches an electrical cable (Figs 1-15) having a conductor core (10) and a sheathing layer (12) covering the core (10), wherein the sheathing layer (12) is made by a synthetic material having an outer surface with a mono color (See Means for Solving the Problem, paragraph 20), wherein the freedom of marking and lay out of the cable can be improved (see abstract under solution). Specifically, with respect to claim 1,

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Kondo teaches an electrical cable (Fig 12) comprising a first mark (83) having a first color and provided on a first part (left end) of an outer surface of the sheathing layer (12), and a second mark (right side of cable, 82) having a second color (see Means for Solving the Problem, paragraph 26) and provided on a second part (right end) of the outer surface of the sheathing layer (12), wherein the second color is provided by an ink feeder (18) that is a different from a first color which is provided by a second ink feeder (20, see Means for Solving the Problem, paragraph 26), wherein the second part (right end) is positioned on a opposite side of the first side (left end) in a lateral direction of the cable (Fig 12), wherein the first mark (left side of cable indicated by 83) is longer than the second mark (right side of cable, 82) in a longitudinal direction of the cable (Fig 12, see Means for Solving the Problem, paragraph 37), wherein the first mark (left end, 83) and the second mark (right end, 82) are positioned at an end of the cable (Fig 12).

With respect to claim 1, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the insulated wire of Masudo to comprise the first and second mark configuration as taught by Kondo because Kondo teaches that such a configuration provides the freedom of marking and lay out of the cable can be improved (see abstract under solution), thereby raising production efficiency (Paragraph 41).

***Response to Arguments***

5. Applicant's arguments filed May 30, 2007 have been fully considered but they are not persuasive. Specifically, the applicant argues the following:

- A) Masudo doesn't disclose the first and second marks being on respective ends because Figures 9a-9b disclose the ends of the cables being cut off.

With respect to argument A, the examiner respectfully traverses. Firstly, it must be stated it has been held that the drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. In re Aslanian, 590 F. 2d 911, 200 USPQ 500 (CCPA 1979). Secondly, the MPEP states:

**2125 Drawings as Prior Art**

**DRAWINGS CAN BE USED AS PRIOR ART**

Drawings and pictures can anticipate claims if they clearly show the structure which is claimed. In re Mraz, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972).

However, the picture must show all the claimed structural features and how they are put together. Jockmus v. Leviton, 28 F.2d 812 (2d Cir. 1928). The origin of the drawing is immaterial. For instance, drawings in a design patent can anticipate or make obvious the claimed invention as can drawings in utility patents. When the reference is a utility patent, it does not matter that the feature shown is unintended or unexplained in the specification.

Given the above stated guidelines, the examiner respectfully submits that the first and second marks are illustrated as being on opposite ends of the cable. Nowhere in the reference does it state that the cable has been cut or severed. Hypothetically speaking, even if the cable had been cut or severed, clearly the end portions of the cable have first and second marking respectively, and therefore would still read on the claim. In

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light of the above stated comments, the examiner respectfully submits that the 35 USC 103(a) rejection is proper and just.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Communication***

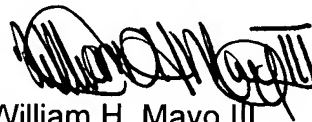
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (571)-272-1978. The examiner can normally be reached on M-F 8:30am-6:00 pm (alternate Fridays off).



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William H. Mayo III  
Primary Examiner.  
Art Unit 2831

WHM III  
August 6, 2007